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PATENT APPLICATION

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400ATTORNEY DOCKET NO. 10007585-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert E. Haines et al.

Confirmation No.: 1660

Application No.: 09/976,630

Examiner: Benjamin A. Ailes

Filing Date: October 11, 2001

Group Art Unit: 2142

Title: Device Configuration Methods and Apparatus

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on July 6, 2007.The fee for filing this Appeal Brief is (37 CFR 1.17(c)) See enclosed Letter A.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ _____. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Typed Name: Natalie King

Signature: 

Rev 15V05a (ApIBrief)

Respectfully submitted,

Robert E. Haines et al.

By 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg No.: 39,833

Date: 9/6/07

Telephone: 509/624-4276

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Rev 1008a (AplBrief)

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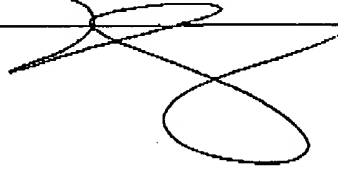
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PATENT APPLICATION
DOCKET NO. 10007585-1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Robert E. Haines

SERIAL NO.: 09/976,630

GROUP ART UNIT: 2142

FILED: October 11, 2001

EXAMINER: B. Ailes

SUBJECT: Device Configuration Method and Apparatus

ASSISTANT COMMISSIONER FOR PATENTS
P.O. BOX 1450
WASHINGTON, D.C. 20231Letter A

Pursuant to the Office Action mailed April 6, 2007, the Office has indicated that no fee is due for filing of this Appeal Brief.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Robert E. Haines

By:



James D. Shaurette

Reg. No. 39,833

Date: 9/6/07

PDNO. 10007585-1

S/N: 09/976,630

Letter A

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/976,630
Filing Date..... October 11, 2001
Inventor.....Robert E. Haines
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 2142
Examiner..... B. Ailes
Attorney's Docket No. PDNO. 10007585-1
Confirmation No..... 1660
Title: Device Configuration Methods and Apparatus

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
Wells, St. John, P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3817

Appellant appeals from the Office Action mailed April 6, 2007 (hereinafter "Office Action"). The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

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**RECEIVED
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The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012486, Frame 0165, and the full assignment to Hewlett-Packard Development Company, L.P. recorded starting at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. The Hewlett-Packard Development Company, L.P., is a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-36 are pending and stand rejected. Claims 37-39 were withdrawn from consideration by the Examiner. Appellant appeals the rejection of claims 1-36.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the Office Action mailed April 6, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to illustrative embodiments of the specification and figures.

Referring to independent claim 1, downloading data including a configuration plug-in and configuration data are depicted in embodiments of Fig. 2 (step S12),

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Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in some embodiments.

Referring to dependent claim 2, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to dependent claim 5, setting of thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to dependent claim 7, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to independent claim 8, downloading is described in embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in some embodiments.

Referring to dependent claim 9, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to dependent claim 12, setting of thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to dependent claim 14, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to independent claim 15, memory is disclosed as reference 24 of Fig. 1 and processing circuitry is disclosed as reference 20 of Fig. 1 in one embodiment. Further, the downloading is described according to embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in some embodiments.

Referring to dependent claim 16, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to dependent claim 17, setting of thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

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Referring to dependent claim 20, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to independent claim 21, downloading of claim 21 is described according to embodiments of Fig. 2 (step S12), Fig. 3 (step S25) and Fig. 6 (step S53). Configuring a hard copy output engine is described at step S26 of Fig. 3 and step S54 of Fig. 6 in some embodiments.

Referring to dependent claim 22, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to dependent claim 25, setting of thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to dependent claim 27, determining a make and model of a hard copy output engine is described in step S13 of Fig. 2 in one embodiment. Determination of thresholds is described in one embodiment in step S24 of Fig. 3.

Referring to dependent claim 28, downloading and setting of thresholds are described in one embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to dependent claim 29, downloading thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to dependent claim 30, setting of thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

Referring to dependent claim 31, in some embodiments, providing user specified information is described at processes P1-P4 of the present application and as shown in Figs. 2-5. Generating at least one of the configuration plug-in and configuration data is described at page 13, line 6 of the specification according to one embodiment.

Referring to dependent claim 34, setting of thresholds is described in one embodiment with respect to steps S24 and S25 of Fig. 3.

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VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

A. The 103 rejections of claims 1-36 over Kageyama and Engel and Kageyama, Engel and Uchida.

B. The 103 rejections of claims 1-14 and 21-33 over Kageyama and Engel and Kageyama, Engel and Uchida.

C. The 103 rejections of claims 1-36 over Kageyama and Engel and Kageyama, Engel and Uchida.

D. The 103 rejection of claims 2 and 7 over Kageyama and Engel.

E. The 103 rejection of claims 9, 14, 16, 20, 22 and 27 over Kageyama and Engel.

F. The 103 rejection of claims 5, 12, 17 and 25 over Kageyama and Engel.

G. The 103 rejection of claim 28 over Kageyama and Engel.

H. The 103 rejection of claims 29-30 over Kageyama and Engel.

I. The 103 rejection of claim 30 over Kageyama and Engel.

J. The 103 rejection of claim 31 over Kageyama and Engel.

K. The 103 rejection of claim 34 over Kageyama and Engel.

L. The 101 rejection of claims 21-27.

VII. ARGUMENT

A. Positively-recited limitations of claims 1-36 are not disclosed nor suggested by Kageyama and Engel and the 103 rejections are improper for at least this reason.

Appellants note that prosecution in this application was re-opened after Appellants filed a previous appeal brief to respond to previous rejections. Appellants respectfully submit the new rejections presented in the Office Action after prosecution was reopened are improper for the reasons set forth herein.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 5). In addition, MPEP 2142 (8th ed., rev. 5) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness*. Appellants respectfully submit that positively-recited limitations of the claims are not disclosed nor suggested by the prior art and the Office has failed to meet its burden of establishing a *prima facie* 103 rejection for at least this reason.

Each of the independent claims 1, 8, 15, and 21 recite *downloading data including configuration data including user-specified information*. At page 3 of the Office Action, the Office relies upon the teachings of col. 15, lines 33-39 of Kageyama as teaching the claimed downloading. The teachings of col. 15 relied upon by the Office are directed to a fourth embodiment which is discussed at col. 13, lines 51+ of Kageyama and which provides that the *printer manufacturer* has updated programs and data for a printer controller. For example, updated programs for improving printing performance or adding or changing a printing function and updated data for solid black patterns, line patterns and font data may be available per col. 13, lines 57+. Appellants have failed to uncover any teachings in Kageyama that the updated programs and data include user-specified information. The Office has failed to provide rationale as to how Kageyama teaches the claimed limitations of *downloading data including configuration data including user-specified information*. Appellants have failed to uncover any teaching in Kageyama of the claimed configuration data including user-specified information. Kageyama merely provides at col. 13, lines 55+ that the printer manufacturer has updated programs and data and fails to state that the updated programs or data include user-specified information as positively claimed.

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Appellants have failed to uncover any teachings in Engel of the positively-claimed limitations of *downloading data including configuration data including user-specified information*. Accordingly, even if the teachings of the references are combined, the combination fails to teach or suggest the positively claimed limitations of the claims.

Appellants respectfully submit that the Office has failed to meet its burden of establishing proper prima facie 103 rejections over the combinations of Kageyama and Engel, and Kageyama, Engel and Uchida for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

B. Positively-recited limitations of claims 1-14 and 21-33 are not disclosed nor suggested by Kageyama and Engel and the 103 rejections are improper for at least this reason.

The independent claims 1, 8 and 21 recite *downloading data including a configuration plug-in including user-specified information*. The Office at page 3 of the Action states that Kageyama fails to disclose a configuration plug-in and relies upon the applet teachings of paragraph 0006 of Engel to cure the deficiencies of Kageyama. Engel at paragraph 0008 teaches loading an applet onto a node and the Office states that the applet is functionally equivalent to the claimed configuration plug-in. However, *Appellants have failed to uncover any teachings that the applet of Engel includes user-specified information*. Paragraph 0008 of Engel teaches loading of the applet itself and then transfer of network configuration parameters to the applet which relays them to the network device per the teachings of 0008 of Engel. Appellants have failed to uncover any teachings in Engel *that the applet which is downloaded is user-specified*. Appellants respectfully submit that positively recited limitations of the claims are not disclosed nor suggested by Kageyama and Engel even if the references are combined.

The Office at pages 3-4 of the Office Action states that one would have found it obvious to utilize a plug-in to perform a step of retrieving information on a network. Appellants respectfully disagree with such modification of Kageyama for reasons presented below in section C, but, even if such a modification were considered to be obvious, Appellants submit such modification of Kageyama fails to

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Brief of Appellant B

teach the claimed limitations of *downloading data including a configuration plug-in including user-specified information*.

Appellants respectfully submit that the Office has failed to meet its burden of establishing proper prima facie 103 rejections over the combinations of Kageyama and Engel and Kageyama, Engel and Uchida for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

C. There is insufficient rationale to combine the teachings of Engel with the teachings of Kageyama and the 103 rejections of claims 1-36 are improper for at least this reason.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The prima facie case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and application. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). As discussed in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984), the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability including some *articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007).

The Office on page 4 of the Office Action states that the combination of Engel with Kageyama is appropriate because Engel teaches the use of the applet reduces cost of device configuration with reference to paragraph 0007 of Engel. Appellants respectfully submit that the Office has failed to present an articulated reasoning with a sufficient rational underpinning to support the legal conclusion of obviousness.

In particular, referring to paragraph 0005 of Engel, the installation of network devices includes configuring the network device with an appropriate set of parameters and the configuration of some prior network device configurations may be implemented using specialized application programs adapted to the network

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devices per paragraph 0006. Plural specialized application programs of Engel are used for different computer system platforms and operating systems to configure network devices during installation. In this context, Engel teaches at 0007 that these specialized application programs increase the cost of network device configuration. Paragraph 0007 is the only mention of "cost" in Engel. Accordingly, the use of the applet of Engel to reduce cost is with respect to arrangements wherein a plurality of specialized application programs are used for different computer system platforms and operating systems to configure network devices during installation. The Office has identified no teachings in Kageyama that different specialized application programs are used for different computer system platforms and operating systems where the implementation of the applet of Engel may be applicable to reduce cost. The Office has provided no evidence or explanation as to how the applet teachings of Engel may reduce cost in the arrangement of Kageyama which is void of use of plural specialized application programs for different computer system platforms and operating systems.

As mentioned above, the objective teachings of Engel teach use of the applet to replace plural specialized application programs used on different computer platforms and operating systems to configure network devices during installation to achieve cost reduction. Appellants respectfully submit the Office has failed to provide a rational underpinning that the cost reduction of Engel applies to arrangements of the applet performing steps of retrieving information on a network alleged to obvious on pages 3-4 of the Office Action. To the contrary, Engel teaches the applet being used to configure the network devices during installation of the same.

Appellants respectfully submit that the reasoning of the Office to combine the references is not supported by the teachings of the prior art, objective evidence or other sufficient rational underpinning.

Appellants respectfully submit that the Office has failed to meet its burden of establishing proper prima facie 103 rejections over the combinations of Kageyama and Engel and Kageyama, Engel and Uchida for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

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D. Positively-recited limitations of claims 2 and 7 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

The claims recite *wherein the configuration plug-in and configuration data include data prepared by determining a make and model for the hard copy output engine and determining user thresholds for consumables associated with the hard copy output engine*. At page 4 of the Office Action, the Office recites database teachings of the printer information DB part 2121 of the printer 200 per cols 5-6 of Kageyama in support of the rejection. The Office has failed to identify any relationship of the teachings of the printer information DB part 2121 to the teachings of col. 15, lines 32+ relied upon as teaching the downloading of claim 1. Furthermore, Appellants have failed to uncover any prior art teachings that col. 15, lines 32+ of Kageyama (regarding the updating the programs and data) or the applet of Engel include data prepared by *determining a make and model for the hard copy output engine and determining user thresholds for consumables associated with the hard copy output engine*.

Furthermore, claim 2 recites determining user thresholds for consumables associated with the hard copy output engine. However, the teachings of cols. 5-6 and Fig. 10 of Kageyama are use information not demonstrated to teach the claimed *determining user thresholds*. Appellants have electronically searched both Kageyama and Engel and failed to uncover any reference to "threshold."

Appellants respectfully submit that the positively recited limitations of the claims are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

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E. Positively-recited limitations of claims 9, 14, 16, 20, 22 and 27 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

The claims recite determining user thresholds for consumables associated with the hard copy output engine. At page 4 of the Office Action, the Office recites database teachings of the printer information DB part 2121 of the printer 200 per cols 5-6 of Kageyama. However, the teachings of Fig. 10 of Kageyama are use information not demonstrated to teach the claimed *determining user thresholds*. Furthermore, Kageyama and Engel are void of any reference to "threshold."

Appellants respectfully submit that the positively recited limitations of the claim are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

F. Positively-recited limitations of claims 5, 12, 17 and 25 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

The claims recite to configure the hard copy output engine using the downloaded data to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed. At page 4 of the Office Action, the Office recites the teachings of Fig. 10 of Kageyama regarding use information of consumable articles per cols. 5-6. The information regarding use of consumables of Kageyama fails to teach configuring of the hard copy output engine or setting of a threshold for the element chosen from the claimed group.

Appellants respectfully submit that the positively recited limitations of the claim are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

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Brief of Appellant B

G. Positively-recited limitations of claim 28 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

Claim 28 recites wherein the downloading comprising downloading a value, and the configuring comprises setting a threshold for a consumable associated with the hard copy output engine using the value.

At page 5 of the Office Action, the Office relies upon the teachings of Kageyama at col. 16, lines 36-41 in support of the rejection. These teachings generically state that programs and data are stored and fail to disclose the claimed limitations of *downloading a value* or *setting a threshold for a consumable using the value* as explicitly claimed. Kageyama is void of any reference to "threshold" or setting a threshold for a consumable.

Appellants respectfully submit that the positively recited limitations of the claim are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

H. Positively-recited limitations of claims 29-30 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

Claim 29 recites wherein the downloading comprising downloading a threshold for replenishment of a consumable associated with the hard copy output engine.

At page 5 of the Office Action, the Office relies upon the teachings of Kageyama at col. 16, lines 36-41 in support of the rejection. These teachings generically state that programs and data are stored and fail to disclose the claimed limitations of *downloading a threshold* or *downloading a threshold for replenishment of a consumable* as explicitly claimed. Kageyama is void of any reference to "threshold" or a threshold for replenishment of a consumable.

Appellants respectfully submit that the positively recited limitations of the claims are not disclosed by the teachings of Kageyama and Engel taken alone or in

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combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

I. Positively-recited limitations of claim 30 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

Claim 30 recites *that the configuring of claim 1 using the downloaded data comprises setting the threshold for replenishment of a consumable associated with the hard copy output engine.*

At page 5 of the Office Action, the Office relies upon the teachings of Kageyama at col. 16, lines 36-41 in support of the rejection. These teachings generically state that programs and data are stored and fail to disclose the claimed limitations of *setting the threshold of the hard copy output engine* as explicitly claimed. Kageyama is void of any reference to "threshold" or setting of a threshold.

Appellants respectfully submit that the positively recited limitations of the claim are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

J. Positively-recited limitations of claim 31 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

Claim 31 recites *providing the user-specified information from a user and generating at least one of the configuration plug-in and configuration data using the user-specified information before the downloading.*

The Office fails to identify any prior art teachings which allegedly disclose the above-recited limitations. Appellants have failed to uncover any teachings in Kageyama or Engel which disclose the above-recited limitations. Appellants

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respectfully submit that the failure of the Office to identify prior art teachings which allegedly teach the above-recited limitations illustrates the inappropriate nature of the prior art rejection.

Appellants respectfully submit that the positively recited limitations of the claim are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

K. Positively-recited limitations of claim 34 are not disclosed nor suggested by Kageyama and Engel and the 103 rejection is improper for at least this reason.

Claim 34 recites wherein the processing circuitry is configured to employ the software module to set a threshold for replenishment of a consumable associated with the hard copy output engine to configure the hard copy output engine.

At page 5 of the Office Action, the Office relies upon the teachings of Kageyama at col. 16, lines 36-41 in support of the rejection. These teachings generically state that programs and data are stored and fail to disclose the claimed limitations of employment of the software module *to set a threshold for replenishment of a consumable* as explicitly claimed. Kageyama is void of any reference to "threshold" or setting of a threshold.

Appellants respectfully submit that the positively recited limitations of the claim are not disclosed by the teachings of Kageyama and Engel taken alone or in combination. Appellants respectfully submit that the Office has failed to meet its burden of establishing a proper prima facie 103 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the rejections of the claims and allowance of the claims.

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L. The 101 rejection of claims 21-27 is not supported by authority and is improper.

Claims 21-27 are forms of propagated signal claims which have been widely recognized and accepted by the Office as patentable. For example, Applicant refers to issued U.S. Patent Nos. 6,792,607; 6,791,971; 6,791,217; 6,789,108; 6,788,692; 6,788,681; 6,785,688; 6,785,609; 6,782,503; 6,779,114; 6,778,980; 6,778,653; 6,775,804; 6,775,581; 6,775,420; 6,774,987; 6,772,148 which also claim in varying forms propagated signal claims. In particular, Applicant refers the Examiner to U.S. Patent No. 6,785,609 issued August 31, 2004 which recites in claim 11 a Beauregard style program storage device claim and in claim 13 of the same patent a propagated signal style recitation claiming a data signal. Also, see U.S. Patent No. 6,775,581 issued August 10, 2004 which recites a storage medium Beauregard style claim in claim 47 and a propagated signal style claim as claim 62.

Appellants note that the Office has failed to identify any authority in support of the 101 rejection. Appellants respectfully submit that the attempt to preclude Appellant from claiming the invention in terms of claims 21-27 is contrary to precedent established by the Office by the common practice of issuing both Beauregard and propagated signal claims in numerous patents issued by the Office. Appellants respectfully submit that denial of Appellants to the same protections as afforded to other patentees is a violation of Appellant's rights under at least the equal protection clause of the 14th Amendment to the U.S. Constitution. Appellants respectfully submit that claims 21-27 are directed towards statutory subject matter as acknowledged by the Office by the issuance of numerous patents including propagated signal claims and Applicant requests withdrawal of the 101 rejection of claims 21-27 for at least these compelling reasons.

M. Conclusion

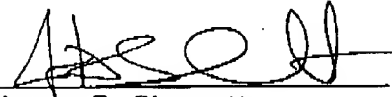
In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

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Respectfully submitted,

Date: 9/6/07

Attorney: 
James D. Shaurette
Reg. No. 39,833

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VIII. CLAIMS APPENDIX

1 1. [Original] A method of configuring a hard copy output engine
2 comprising:
3 downloading data including a configuration plug-in and configuration data
4 each including user-specified information; and
5 configuring the hard copy output engine using the downloaded data.

1 2. [Original] The method of claim 1, wherein the configuration plug-in
2 and configuration data include data prepared by:
3 determining a make and model for the hard copy output engine; and
4 determining user thresholds for consumables associated with the hard
5 copy output engine.

1 3. [Original] The method of claim 1, wherein downloading includes:
2 sending an electronic message via the Internet to a website for a vendor
3 associated with the hard copy output engine; and
4 receiving an electronic message via the Internet in response to sending.

1 4. [Original] The method of claim 1, wherein downloading includes:
2 sending an electronic message via the Internet to a vendor associated
3 with the hard copy output engine; and
4 receiving an electronic message via the Internet in response to sending,
5 wherein sending and receiving include transmission across a firewall.

1 5. [Original] The method of claim 1, wherein configuring includes
2 setting a threshold for an element chosen from a group consisting of:
3 pigmentation material, marking material, number of hours of operation and
4 number of sheets of print media consumed.

1 6. [Original] The method of claim 1, wherein the hard copy output
2 engine is chosen from a group consisting of: facsimile machines, photocopiers
3 and printers.

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1 7. [Original] The method of claim 1, wherein the configuration plug-in
2 and configuration data include data prepared by:
3 determining a make and model for the hard copy output engine;
4 determining a serial number for the hard copy output engine; and
5 determining user thresholds for consumables associated with the hard
6 copy output engine.

1 8. [Original] An article of manufacture comprising a computer usable
2 medium having computer readable code embodied therein that is configured to
3 cause a processor to:
4 download data including a configuration plug-in and configuration data
5 each including user-specified information; and
6 configure a hard copy output engine using the downloaded data.

1 9. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to:
5 determine a make and model for the hard copy output engine; and
6 determine user thresholds for consumables associated with the hard copy
7 output engine.

1 10. [Previously Presented] The article of manufacture of claim 8,
2 wherein the computer readable code configured to cause the processor to
3 download data includes computer readable code that when executed causes the
4 processor to:
5 send a first electronic message across a firewall via the Internet to a
6 website for a vendor associated with the hard copy output engine; and
7 receive a second electronic message across the firewall via the Internet in
8 response to the first electronic message.

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1 11. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to download data
3 includes computer readable code configured to cause the processor to:

4 send a first electronic message across a firewall via the Internet to a
5 website for a vendor associated with the hard copy output engine; and

6 receive a second electronic message across a firewall via the Internet in
7 response to the first electronic message.

1 12. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to configure the hard copy output engine using the downloaded data
5 to set a threshold for an element chosen from a group consisting of:
6 pigmentation material, marking material, number of hours of operation and
7 number of sheets of print media consumed.

1 13. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to configure a hard copy output engine chosen from a group
5 consisting of: facsimile machines, photocopiers and printers.

1 14. [Original] The article of manufacture of claim 8, wherein the
2 computer readable code configured to cause the processor to configure the hard
3 copy output engine includes computer readable code configured to cause the
4 processor to:

5 determine a make and model for the hard copy output engine;

6 determine a serial number for the hard copy output engine; and

7 determine user thresholds for consumables associated with the hard copy
8 output engine.

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1 15. [Previously Presented] A computer implemented control system for
2 a hard copy output engine, the system comprising:
3 memory configured to store a software module; and
4 processing circuitry configured to employ the software module to:
5 download data including configuration data including user-specified
6 information; and
7 configure a hard copy output engine using the downloaded data.

1 16. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module
3 further comprises processing circuitry configured to employ the software module
4 to:
5 determine a make and model for the hard copy output engine; and
6 determine user thresholds for consumables associated with the hard copy
7 output engine.

1 17. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module to
3 configure includes processing circuitry configured to employ the software
4 module to configure the hard copy output engine using the downloaded data to
5 set a threshold for an element chosen from a group consisting of: pigmentation
6 material, marking material, number of hours of operation and number of sheets
7 of print media consumed.

1 18. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module
3 further includes processing circuitry configured to employ the software module
4 to:
5 send a first electronic message across a firewall via the Internet to a
6 vendor associated with the hard copy output engine; and
7 receive a second electronic message across the firewall via the Internet in
8 response to the first electronic message.

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1 19. [Original] The computer implemented control system of claim 15,
2 wherein the hard copy output engine is chosen from a group consisting of:
3 facsimile machines, photocopiers and printers.

1 20. [Original] The computer implemented control system of claim 15,
2 wherein the processing circuitry configured to employ the software module
3 further comprises processing circuitry configured to employ the software module
4 to:

5 determine a make and model for the hard copy output engine;
6 determine a serial number for the hard copy output engine; and
7 determine user thresholds for consumables associated with the hard copy
8 output engine.

1 21. [Original] A computer instruction signal embodied in a carrier wave
2 carrying instructions that when executed by a processor cause the processor to:
3 download data including a configuration plug-in and configuration data
4 each including user-specified information; and
5 configure a hard copy output engine using the downloaded data.

1 22. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to:

6 determine a make and model for the hard copy output engine; and
7 determine user thresholds for consumables associated with the hard copy
8 output engine.

1 23. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to download data includes a computer instruction
4 signal carrying instructions that cause the processor to:

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5 send a first electronic message across a firewall via the Internet to a
6 website for a vendor associated with the hard copy output engine; and
7 receive a second electronic message across the firewall via the Internet in
8 response to the first electronic message.

1 24. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to download data includes a computer instruction
4 signal carrying instructions that when executed cause the processor to:
5 send a first electronic message across a firewall via the Internet to a
6 website for a vendor associated with the hard copy output engine; and
7 receive a second electronic message across a firewall via the Internet in
8 response to the first electronic message.

1 25. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to configure the hard copy output engine using the downloaded data
6 to set a threshold for an element chosen from a group consisting of:
7 pigmentation material, marking material, number of hours of operation and
8 number of sheets of print media consumed.

1 26. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to configure a hard copy output engine chosen from a group
6 consisting of: facsimile machines, photocopiers and printers.

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1 27. [Original] The computer instruction signal of claim 21, wherein the
2 computer instruction signal embodied in the carrier wave carrying instructions
3 that cause the processor to configure the hard copy output engine includes a
4 computer instruction signal carrying instructions that when executed cause the
5 processor to:

6 determine a make and model for the hard copy output engine;
7 determine a serial number for the hard copy output engine; and
8 determine user thresholds for consumables associated with the hard copy
9 output engine.

1 28. [Previously Presented] The method of claim 1, wherein the
2 downloading comprising downloading a value, and the configuring comprises
3 setting a threshold for a consumable associated with the hard copy output
4 engine using the value.

1 29. [Previously Presented] The method of claim 1, wherein the
2 downloading comprising downloading a threshold for replenishment of a
3 consumable associated with the hard copy output engine.

1 30. [Previously Presented] The method of claim 29, wherein the
2 configuring comprises setting the threshold of the hard copy output engine.

1 31. [Previously Presented] The method of claim 1, further comprising:
2 providing the user-specified information from a user; and
3 generating at least one of the configuration plug-in and configuration data
4 using the user-specified information before the downloading.

1 32. [Previously Presented] The method of claim 1, wherein the
2 configuring comprises altering the hard copy output engine.

1 33. [Previously Presented] The method of claim 1, wherein the
2 configuring comprises altering an operation of the hard copy output engine with
3 respect to formation of hard images upon paper.

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1 34. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry is configured to employ the
3 software module to set a threshold for replenishment of a consumable
4 associated with the hard copy output engine to configure the hard copy output
5 engine.

1 35. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry is configured to employ the
3 software module to configure the hard copy output engine comprising altering
4 the hard copy output engine.

1 36. [Previously Presented] The computer implemented control system
2 of claim 15, wherein the processing circuitry is configured to employ the
3 software module to configure the hard copy output engine comprising altering an
4 operation of the hard copy output engine with respect to formation of hard
5 images upon paper.

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IX. EVIDENCE APPENDIX

Appellants submit no evidence with this appellate brief.

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X. RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related proceedings.

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